

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated December 6, 2004 (hereinafter Office Action) have been considered. Claims 1-59 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Pursuant to the provisions of M.P.E.P. 609, it is requested that the Examiner return a copy of the PTO Form 1449 originally filed by the Applicant on January 2, 2002, marked as being considered and initialed by the Examiner, to the undersigned with the next official communication.

Claims 1 and 15-59 have been amended and Claims 60-63 have been added. The Claims that were originally numbered 16-60 have been amended to correct a typographical error in the claim numbering. Independent Claims 1, 16, 31, 43, 55 have been amended to remove references to "a user" in the preamble. Claims 38 and 50 have been amended for purposes of antecedent basis only. The above amendments were not made in response to prior art or any objections/rejections.

Claims 1-59 stand rejected under 35 U.S.C. §102(b) 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,948,040 to *DeLorme, et al.* (hereinafter *DeLorme*) in view of U.S. Patent No. 6,204,840 to *Petelycky, et al.* (hereinafter *Petelycky*). The Applicant respectfully traverses the rejections of Claims 1-59. According to MPEP §2142, to establish a *prima facie* case of obviousness under 35 U.S.C. §103:

- 1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Applicant respectfully submits that the combination of *DeLorme* in view of *Petelycky* does not teach or suggest all of the limitations of Claims 1-59, nor newly added

claims 60-63. Further, even if these references did teach any of the claim limitations, there is no motivation to combine the reference teachings as suggested by the Office Action.

As to independent Claims 1, 16, 31, 43, 55, and 60-63, *DeLorme* describes a computerized travel reservation system that generates travel itineraries and “map tickets.” The reservation system of *DeLorme* accesses geographic, temporal, topical, and transaction data related to traveling. *DeLorme* describes presenting this data to travelers in various forms, including as a graphical display on a PDA (col. 18 lines 25-32). This graphical data may be presented in a reduced format for a portable, wireless device (e.g., the WCU 907)(col. 73 lines 54-63). *DeLorme* describes transferring “simplified” multimedia content to a portable device, but is silent as to previewing multimedia samples on the device. For example, *DeLorme* describes transferring the entire relevant content onto the device (col. 72, lines 23-33), and does not discuss any sort of previews. Additionally, as admitted in the Office Action, *DeLorme* fails to describe any specific mechanisms for “simplifying” the content. In particular, *DeLorme* fails to at least describe providing a first and second set of parameters used to dynamically extract a preview sample for transmission to a mobile terminal.

Petelycky fails to remedy the deficiencies of *DeLorme*. *Petelycky* describes a non-timeline, non-linear program for editing digital multimedia. *Petelycky* arguably discloses interactively selecting parameters such as size, scaling, and frame rate (col. 17, lines 30-37) to preview of an in-production multimedia work, but *Petelycky* does not disclose providing a first set of parameters associated with a size of a preview sample of the multimedia content and providing a second set of parameters associated with composition of the preview sample to dynamically extract a preview sample for transmission to a mobile terminal. *Petelycky* only describes self-contained previews used by multimedia editing software, which is entirely different from using selected parameter sets for preparing previews for transmission to mobile devices. Therefore, a *prima facie* case of obviousness has not been established because neither *DeLorme* nor *Petelycky* describe providing a first and second set of parameters used to dynamically extract a preview sample for transmission to a mobile terminal, and therefore a combination of these references fails to teach or suggest at least these claimed features. Claims 1, 16, 31, 43, 55, and 60-63 are thus in condition for allowance.

The deficiencies in the combination of *DeLorme* and *Petelycky* described above apply to each of the independent Claims 1, 16, 31, 43, 55, and 60-63. In addition, as per independent claims 16, 43, and 60-63, neither *DeLorme* nor *Petelycky*, either alone or in combination, disclose a profile database that stores mobile profiles or user profiles. In the portions of *DeLorme* cited in the rejection of Claim 16 (col. 13, line 1 and FIG. 3), *DeLorme* merely describes a relational database model that may be used for organizing travel data. Nowhere does *DeLorme* describe data objects that may be used to obtain parameters relating to either the size of a preview sample or the composition of the preview sample. Therefore the combination of *DeLorme* and *Petelycky* fail to disclose such a profile database, and Claims 16, 43, and 60-63 are further allowable over the cited references.

In addition, the Applicant respectfully submits that there is no motivation to combine these references. *DeLorme* recognizes that a mobile device may have limited capacity to handle multimedia objects, but does not address how to reduce the size of the multimedia objects. More particularly, *DeLorme* does not recognize the use of multimedia previews, which may provide other benefits besides reduction of data size. *Petelycky* recognizes that preview windows are useful in the context of a single user multimedia editing application. The purpose of previews in *Petelycky* is to provide the editor “immediate feedback and visual confirmation of the special effect” (col. 13, lines 64-65). The user-interactive nature of *Petelycky*’s preview windows distinguish them from the previews described in Applicant’s invention, the latter operating without the user having to provide any interaction. *Petelycky* does not use previews to solve problems inherent in providing multimedia to mobile devices, such as limited or expensive network bandwidth and variable device capability. Thus, one having ordinary skill in the art would not be motivated to apply the previews of *Petelycky* to a mobile device, because *Petelycky* uses previews in an entirely different context and for an entirely different purpose. Because motivation to combine *DeLorme* with *Petelycky* is lacking, a *prima facie* case of obviousness has not been established, and Claims 1-63 are in condition for allowance over the cited combination of references.

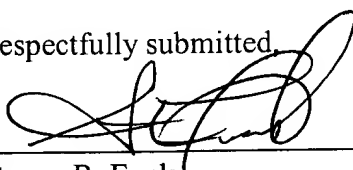
The inapplicability of the *DeLorme* and *Petelycky* combination is even more apparent when applied to the dependent claims. With reference to dependent Claim 2, *DeLorme* (col. 17, lines 35-45), contrary to what is set forth in the Office Action, does not disclose a set of

parameters that include maximum downloading time or maximum downloading cost. *DeLorme* merely describes costs associated with travel planning. Travel planning costs as presented in *DeLorme* are entirely different than costs associated with downloading time and cost, the latter typically being associated with network bandwidth usage. Similarly, with respect to Claim 4, the Office Action fails to indicate where within the *DeLorme* or *Petelycky* references actual transmission bit rate values or estimated bit rate values are disclosed. This would appear to be a result of the scant details relating to mobile implementations in *DeLorme*, and the fact that *Petelycky* is not concerned at all with transmissions to mobile devices. The Applicant respectfully submits that these references indeed fail to teach at least the feature in Claim 4 relating to actual transmission bit rate values or estimated bit rate values.

In addition to the above arguments, Applicant notes that Dependent Claims 2-15, 17-30, 32-42, 44-54, and 56-59 are dependent from independent Claims 1, 16, 31, 43, and 55, respectively, and also stand rejected under 35 U.S.C. §103(a) as being unpatentable over *DeLorme* and *Petelycky*. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are now moot in view of the remarks made in connection with independent Claims 1, 16, 31, 43, and 55. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 2-15, 17-30, 32-42, 44-54, and 56-59 are also in condition for allowance.

If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at 651-686-6633 (x110) to discuss any issues related to this case.

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Respectfully submitted,
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